

## **TABLE OF CONTENTS**

<b>I. REAL PARTY IN INTEREST .....</b>	<b>1</b>
<b>II. RELATED APPEALS AND INTERFERENCES .....</b>	<b>2</b>
<b>III. STATUS OF CLAIMS .....</b>	<b>2</b>
<b>IV. STATUS OF AMENDMENTS.....</b>	<b>2</b>
<b>V. SUMMARY OF CLAIMED SUBJECT MATTER .....</b>	<b>2</b>
<b>VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL .....</b>	<b>3</b>
<b>VII. ARGUMENT .....</b>	<b>4</b>
<b>VIII. CLAIMS APPENDIX.....</b>	<b>20</b>
<b>IX. EVIDENCE APPENDIX.....</b>	<b>22</b>
<b>X. RELATED PROCEEDINGS APPENDIX.....</b>	<b>23</b>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Radhika AGGARWAL, et al.	:	Confirmation Number: 2419
	:	
Application No.: 10/041,141	:	Group Art Unit: 2178
	:	
Filed: January 3, 2002	:	Examiner: T. Huynh
	:	
For: INLINE ERROR HIGHLIGHTING	:	

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed January 14, 2009, in response to the Examiner reopening prosecution in the Office Action dated April 29, 2009, and in response to the Examiner reopening prosecution in the Office Action dated November 13, 2009, wherein Appellants appeal from the Examiner's rejection of claims 1-5.

**I. REAL PARTY IN INTEREST**

This application is assigned to IBM Corporation by assignment recorded on January 3, 2002, at Reel 012482, Frame 0318.

## **II. RELATED APPEALS AND INTERFERENCES**

On August 29, 2007, a Decision on Appeal was rendered in the present Application. Appellants are unaware of any other related appeals and interferences.

## **III. STATUS OF CLAIMS**

Claims 1-5 and 11 are pending in this Application. Claims 1-5 and 11 have been rejected, and claims 6-10 have been cancelled. It is from the multiple rejections of the claims that this Appeal is taken.

## **IV. STATUS OF AMENDMENTS**

The claims have not been amended subsequent to the imposition of the Ninth Office Action dated November 13, 2009 (hereinafter the Ninth Office Action).

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

1 Independent claim 1 is directed to an inline error notification method. Referring to  
2 Figure 3 and pages 10-12 of Appellants' specification, a validation error is detected in block 310  
3 based upon a value provided through an input-element in a markup specified form (page 10, line  
4 20 through page 11, line 6). In block 314, a suitable textual error message is selected based upon  
5 the type of validation error which has occurred (page 11, lines 16-19). In block 316, markup  
6 specifying the row is inserted into the markup specifying the form at a position which is  
7 proximate to the input-element which gave rise to the validation error (page 11, lines 19-24).  
8 Also in block 316, the textual error message selected in block 314 is inserted into a row (page 12,  
9 lines 1-2). To visually distinguish the inline error notification from the rest of the form, the

1 background of the row assumes a color which differs from the colors of the input element and its  
2 surroundings (page 12, lines 2-4). In step 318, an anchor tag is applied proximately to the input-  
3 element (page 12, lines 6-8). In consequence, when the page containing the form is reloaded, the  
4 anchor is specified in the URL causing the page to scroll to a position which is proximate to the  
5 input-element (page 12, lines 8-10).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1-2 and 5 were rejected under 35 U.S.C. § 103 for obviousness based upon Upton et al., U.S. Patent Publication No. 2003/0104884 (hereinafter Upton), in view of Jeffries et al., U.S. Patent No. 6,094,529 (hereinafter Jeffries), and Homer et al., "Instant HTML," copyright 1997, pages 88-101 (hereinafter Homer); and

2. Claims 3-4 were rejected under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries and Homer and further in view of Hartmann, U.S. Patent No. 6,615,226.

**VII. ARGUMENT**

**THE REJECTION OF CLAIMS 1-2 AND 5 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS  
BASED UPON UPTON IN VIEW OF JEFFRIES AND HOMER**

For convenience of the Honorable Board in addressing the rejections, claims 2 and 5 stand or fall together with independent claim 1.

**Actual Reduction to Practice**

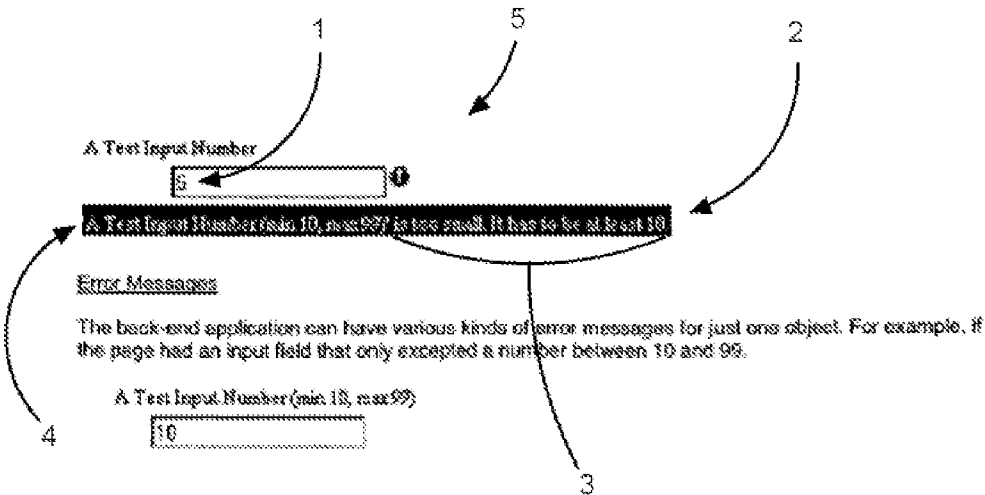
In the Declaration dated December 13-15, 2004 (hereinafter the First Declaration), Appellants declared the following in the fourth enumerated paragraph on page two:

At the time of submitting the Disclosure an experimental prototype of the Invention had been created and work had begun in producing a production version of the Invention.

In response, the Examiner asserted the following on page 7 of the Third Office Action dated September 2, 2005:

This is not persuasive. The Declaration filed on 12/21/2004 fails to provide evidence(s) to show that the prototype was actually reduced to practice. The Declaration provides "a disclosure document" which "describing an embodiment of the Invention". The disclosure includes demonstration of error message displayed in a row below a user input field. However, the disclosure does not provide test results demonstrate that the test was in fact successful as the disclosure described. Therefore, the evidence is not persuasive and the rejection is being maintained. (emphasis added)

Appellants disagreed with the Examiner. The result of a successful test is found on page 2 of Exhibit A from the First Declaration. This result is reproduced below:



Referring to item (1), at least one validation error was detected in a form-based submit based upon a value provided through an input-element in a markup specified form. In this example, the input-element in the markup specified form is represented by the box surrounding "5," the value is "5," and the validation error is that the value is not between 10 and 99.

Referring to item (2), a row is inserted in the markup specified form in a position which is proximate to the input-element, and the row has a background color which differs from other colors which are visible in proximity to the inserted row. In this example, the row is immediately below the input-element (i.e., the box surrounding "5") and has a different background color.

Referring to item (3), error text corresponding to the validation error is selected and inserted in the row. In this example, the text (i.e., "is too small. It has to be at least 10") has

1 been selected and corresponds to the validation error. This text has also been inserted into the  
2 row.

3  
4 Referring to items (4) and (5), an anchor tag has been inserted in the markup specified  
5 form in a position which is proximate to the input-element, and the markup specified form is  
6 served in a response to the form-based submit with the response referencing the anchor tag. The  
7 serving and display of the markup specified form is what is shown and is a result of a successful  
8 test of Appellants' claimed invention. Appellants, therefore, previously argued that sufficient  
9 evidence has been submitted in the First Declaration to establish that actual reduction to practice  
10 of the claimed invention occurred prior to the filing date of Upton.

11  
12 Constructive Reduction to Practice

13 The following arguments were originally presented in the Response filed July 5, 2005. In  
14 the Final Office Action dated May 6, 2005 (hereinafter the Second Office Action), the Examiner  
15 questioned the diligence from prior to October 18, 2001 (the filing date of Upton et al.) until  
16 Appellants' constructive reduction to practice date of January 3, 2002 (the filing date of the  
17 present application). M.P.E.P. § 715.07 discusses "Three Ways to Show Prior Invention." The  
18 Examiner's comments are with regard to showing (C), which is constructive reduction to  
19 practice.

20  
21 Notwithstanding Appellants' assertion that showing (A) has been established, Appellants  
22 also submit that the requirements of showing (C) have also been met. As discussed in M.P.E.P.  
23 § 715.07(a) and noted by the Examiner on page 8 of the Second Office Action, due diligence is

1 required from just prior to the reference date to the filing date of the application. The reference  
2 date of Upton is October 18, 2001, and on October 29, 2001, Appellants reviewed a final draft of  
3 the application, and on November 8, 2001, Appellants executed the "Declaration and Power of  
4 Attorney for Patent Application" for the present application. Given the closeness of these dates,  
5 Appellants submit that due diligence was exercised between just prior to the reference date of  
6 Upton and the execution of the "Declaration and Power of Attorney for Patent Application."  
7

8 As noted in M.P.E.P. § 2138.06, "[r]easonable diligence is all that is required of the  
9 attorney" and "[i]f the attorney has a reasonable backlog of unrelated cases which he takes up in  
10 chronological order and carries out expeditiously, that is sufficient." As is readily apparent from  
11 the dates, there are three major holidays (i.e., Thanksgiving, Christmas, and New Years) between  
12 November 8, 2001 (the date that the Declaration and Power of Attorney for Patent Application  
13 was executed by Appellants) and January 3, 2002 (the filing date of the present application).  
14 International Business Machines Corporation, the assignee of the present application, is  
15 consistently the largest filer of patent applications with the USPTO.<sup>1</sup> Given the unmatched  
16 number of applications filed each year by IBM and the number of major holidays that occurred  
17 between the aforementioned dates, Appellants respectfully submit that the period of time  
18 between the execution date of the Declaration and Power of Attorney for Patent Application and  
19 the filing date of the present application is not unreasonable, and thus, IBM's attorneys exercised  
20 reasonable diligence in filing the present patent application. Therefore, Appellants submit that  
21 the requirements of showing (C) have also been met.  
22

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<sup>1</sup> See, USPTO TODAY, Volume 3, No. 1, January 2002 (In a preliminary list, IBM ranked #1 with 3,411 patent issued in 2001); In a preliminary list, IBM ranked #1 with 3,288 patents issued in 2002  
<http://www.uspto.gov/web/offices/com/speeches/03-01.htm>.



1  
2 In the Declaration dated March 11, 2005 (hereinafter the Second Declaration), Appellants  
3 presented facts that established that Appellants' attorneys engaged in reasonable diligence in  
4 filing the present application.<sup>2</sup> As declared, during the time period between November 8, 2001  
5 (the date on which the Declaration and Power of Attorney was executed by Appellants) and  
6 January 3, 2002 (the filing date of the present application), the application was taken up in the  
7 ordinary course of ongoing work in roughly chronological order from when the application was  
8 received, and during that time, (20) twenty patent application were handled.

9  
10 On page 8 of the Fourth Office Action, the Examiner responded to the Second  
11 Declaration as follows:

12 It is noted that diligence must be proven from prior to Oct 18, 2001 (the filing date of  
13 Upton et al.) until applicants' reduction to practice (constructive) Jan 03, 2002. Based upon the  
14 evidence presented in declarations filed on 12/05/05, there are apparent periods lacking activity  
15 and explanation from 10/18/01 to 10/29/01 and 11/08/01 to 01/03/02. Although, applicants points  
16 out that there are three holidays and provide a listing of 20 patent applications between 11/08/01  
17 to 01/03/02 period, however, applicants does not explain activities or procedures involving to such  
18 applications on this period except such holidays. The declaration fails to provide activities and  
19 particular facts associated with time that applicants are relying on to show completion without  
20 unexplained time gaps. Since the evidence is not persuasive, the rejection is being maintained.  
21

22 Appellants respectfully submit that the Examiner is placing a moving target in front of  
23 Appellants. The Second Declaration was prepared based upon an interview that Appellants'  
24 representative had with the Examiner on September 20, 2005, and also based upon an telephone  
25 discussion that Appellants' representative had with a USPTO specialist regarding Declarations  
26 under 37 C.F.R. § 1.131. Appellants were under the impression that the Second Declaration  
27 would cure the alleged deficiencies of the First Declaration with regard to reasonable diligence.

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<sup>2</sup> See M.P.E.P. § 2138.06. *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

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Instead of explaining why the facts presented by Appellants did not establish that Appellants' attorneys engaged in reasonable diligence in filing the present application, the Examiner simply asked for additional information that was not asked for (but could have been asked for) during the personal interview on September 20, 2005, that Appellants' representative had with the Examiner with regard to this very issue.

Appellants are also unclear as to what probative value the "activities or procedures involving to such applications" will have on the issue as to whether or not Appellants' attorneys engaged in reasonable diligence. The fact of the matter is that the total time spent by all persons (e.g., inventors; attorneys and their staff; and examiners/Board and their staff) in taking an inventive concept from when a patent disclosure was generated to when the application issues as a patent is likely less than 1 month or perhaps even less than 1 week (i.e., 168 hours). However, in the case of the present application over 8 years have passed and yet the application is still being prosecuted. Had the Appellants and the USPTO exhibited perfect diligence with regard to this particular application, a final disposition on this application would have occurred 8 years ago. However, "perfect diligence" is not required. Instead, only reasonable diligence is required. Appellants' position is that the Examiner has failed to set forth any reasoned arguments to rebut the facts presented by Appellants as to Appellants' reasonable diligence in prosecuting the present application.

Based upon the aforementioned arguments, Appellants have established both actual and constructive reduction to practice prior to the filing date of Upton. Since all of the Examiner's rejections rely upon Upton, Appellants' position is that none of these rejections can be sustained.

Examiner's First Response – Actual Reduction to Practice

The above-reproduced arguments (incorporated herein) were previously presented on pages 5-8 of the Amendment dated April 28, 2008. Referring to page 7 of the Sixth Office Action dated July 25, 2008 (hereinafter the Sixth Office Action), the Examiner responded as follows:

Applicant's arguments, see remarks, pages 3-6, filed on 4/28/08, with respect to the rejection(s) of claim(s) 1-5 have been fully considered and are persuasive. The Declaration filed on 12/21/04 is sufficient overcome the Upton reference and the effective date is back to 12/26/2000 that is the last modified exhibit [sic] A filed with the Declaration on 12/21/04. However, upon further consideration, a new ground(s) of rejection is made in view of Radtke, Jefferies, Hartman and Homer as explained in the rejection above.

Thus, the Examiner has admitted that Appellants have submitted sufficient evidence to establish actual reduction to practice prior to the filing date of Upton. Therefore, since Upton cannot be properly relied upon in rejecting claim 1, the Examiner has committed legal error in maintaining the rejection of claims 1-2 and 5 based upon Upton in view of Jeffries and Homer.

Examiner's Second Response – Actual Reduction to Practice

Despite agreeing with Appellants that sufficient evidence was submitted in the First Declaration to establish actual reduction to practice within the Sixth, Seventh, and Eighth Office Actions, the Examiner has done a complete reversal in the Ninth Office Action. Specifically, on page 9 of the Ninth Office Action, the Examiner asserted the following:

Applicants primarily argue that "The "result" of successful test is found on page 2 of Exhibit A from the First Declaration" (Appeal brief, page 5)

This is not persuasive. The disclosure document on page 2 of Exhibit A includes demonstration of error message displayed in a row below a user input field. However, the disclosure does not provide test results demonstrate that the test was in fact successful as the disclosure described.

Appellants respectfully submit that the Examiner has failed to provide sufficient support for the Examiner's conclusion statement that "the disclosure does not provide test results [that] demonstrate that the test was in fact successful." In this regard, reference is made to subparagraph (B) of M.P.E.P. § 716.01, entitled "Consideration of Evidence," which is reproduced below:

Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the prima facie case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient. (emphasis added)

The Examiner's assertion that "the disclosure does not provide test results [that] demonstrate that the test was in fact successful" is a general conclusory statement without specificity. The Examiner has not explained why the result found on page 2 of Exhibit A from the First Declaration was not, in fact, successful. Moreover, the Examiner has not explained what a successful test result look like or why the submitted evidence in the First Declaration as to a successful test is insufficient.

The result of the claimed method would be outputted on a computer screen. Additionally, such a result would look similar to what is illustrated on page 2 of Exhibit A from the First Declaration and reproduced on page 5 of the present Appeal Brief. Thus, the test result submitted as part of the First Declaration provides sufficient evidence to establish that a successful test was made.

1 Since (i) the Examiner has, at one time, already agreed that Appellants have submitted  
2 sufficient evidence to establish actual reduction to practice prior to the filing date of Upton and (ii)  
3 the Examiner has not set forth an adequate explanation supporting the Examiner's new assertion that  
4 the evidence is insufficient, Appellants respectfully request that the Honorable Board hold (i) that  
5 the Examiner did not successfully rebut Appellants' evidence of actual reduction to practice and (ii)  
6 Appellants have submitted sufficient evidence to establish actual reduction to practice prior to the  
7 filing date of Upton.

8  
9 Examiner's Response – Constructive Reduction to Practice

10 Also referring to page 7 of the Sixth Office Action, with regard to Appellants' arguments as  
11 to constructive reduction to practice, the Examiner responded as follows

12 This is not persuasive. Based on applicants' submitted evidence, there is time gaps of  
13 lacking activity and explanation, that is from the filing date of Upton reference 10/18/01 to Final  
14 Draft 10/29/01 and from the Final Draft 10/29/01 to Declaration signed instant application  
15 11/8/01. It is also appears that applicants do not explain how the provided exhibit A (Attorney  
16 Docket) indicating "the application was taken up in the ordinary course of ongoing work in  
17 roughly chronological order from when the application was received". Therefore, the declaration  
18 filed on 12/05/05 fails to provide activities and particular facts associated with time that applicants  
19 are relying on to show completion without unexplained time gaps.  
20

21 The Examiner's "response" is non-responsive since it merely repeats what the Examiner already  
22 asserted on page 8 of the Fourth Office Action dated February 24, 2006 (hereinafter the Fourth  
23 Office Action).

24  
25 Appellants are unclear as to the level of detail requested by the Examiner. Does the  
26 Examiner want a week-by-week discussion, a day-by-day discussion, an hour-by-hour discussion,  
27 or even a minute-by-minute discussion of the "time gaps" alleged by the Examiner? As previously  
28 noted, Appellants' representative had a discussion with a USPTO specialist regarding Declarations  
29 under 37 C.F.R. § 1.131 and Appellants' representative was left with the impression that the

1 Second Declaration would cure the alleged deficiencies of the First Declaration with regard to  
2 reasonable diligence.

3  
4 The Examiner's "response" leaves Appellants unclear as to how to proceed. The  
5 Examiner's does not explain what level of detail is needed to explain the alleged time gaps –  
6 instead, the Examiner just alleges that the declaration is not sufficient without explaining what  
7 would be sufficient. Therefore, Appellants' position remains that the Examiner has failed to set  
8 forth any reasoned arguments to rebut the facts presented by Appellants as to Appellants'  
9 reasonable diligence in prosecuting the present application. Therefore, not only has Appellants  
10 establish actual reduction to practice prior to the critical date, Appellants have also established  
11 construction reduction to practice.

---

12  
13  
14 Res Judicata

15  
16 Sixth and Seventh Office Action

17 As previously noted, the Examiner has already admitted that Appellants have submitted  
18 sufficient evidence to establish actual reduction to practice prior to the filing date of Upton. As a  
19 result, in the Sixth Office Action, the Examiner withdrew the rejection of claims 1-2 and 5 based  
20 upon Upton in view of Jeffries and Homer. However, in the Sixth Office Action, The Examiner,  
21 however, rejected claims 1-4 based upon the new combination of Radtke, Hartmann, Jeffries, and  
22 Homer. In the Seventh Office Action, the Examiner maintained this rejection.

Eighth Office Action

In response to an Appeal Brief filed by Appellants on January 14, 2009 (hereinafter the Second Appeal), the Examiner withdrew the rejection based upon the combination of Radtke, Hartmann, Jeffries, and Homer and reinstated the old rejection of Upton in view of Jeffries and Homer. The basis for the Examiner's rejection is *res judicata* and in the second enumerated paragraph spanning pages 2 and 3 of the Eighth Office Action, the Examiner reproduced, nearly word-for-word, the entirety of M.P.E.P. § 706.03(w), entitled "Res Judicata."

Referring to page 3 of both the Eighth and Ninth Office Actions, the Examiner then made the following assertions:

- a. Board affirmed the rejections of claims 1-10 on 08/29/2007.
- b. The RCE and amended claims are filed on 10/29/07. The claims have been substantially amended to require a new ground of rejections using an additional prior art reference.
- b. The amendment is filed 4/28/08 comprising amended claims 1-5 having limitations exactly the same limitations of claims 1-5 respectively that have been affirmed by the Board decision. Therefore, amended claims 1-5 filed on 4/28/2008 are rejected under the ground of *Res Judicata* as and made final.
- d. Examiner herein vacates the office actions mailed on 7/25/2008 and 10/14/2008. It is noted that the Declaration (filed on 12/21/04 and 12/05/05) are filed before the Appeal Brief (filed on 7/13/06). Thus, this Declaration is also binding with the Board decision and the examiner does not further consider the Declaration. (emphasis in original)

Of particular interest is the Examiner's assertion that "this Declaration is also binding with the Board decision and the examiner does not further consider the Declaration." This statement does not have any known legal relevance or known legal support, and therefore, Appellants proceed on the basis that the Examiner was attempting to assert something else. Regardless, the Examiner's assertion that "this Declaration is also binding with the Board decision" is incorrect.

Not only did the Honorable Board not consider the First or Second Declarations or Appellants' arguments with regard to these Declarations, these Declarations were never presented

1 in the First Appeal Brief, which resulted in the Decision dated August 29, 2007. Referring to the  
2 Evidence Appendix on page 14 of the First Appeal Brief dated July 13, 2006 (hereinafter the  
3 First Appeal Brief), it was stated:

4 No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of  
5 any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal,  
6 and thus no evidence is attached hereto.  
7

8 Thus, neither of the First and Second Declarations were considered by the Honorable Board and  
9 rendering its Decision. Therefore, these Declarations are not "binding with the Board decision"  
10 since the Decision did not consider or rely upon these Declarations.  
11

12 Although apparently not recognized by the Examiner, 10 out of the 14 cases cited within  
13 this section of the M.P.E.P. § 706.03(w) (and reproduced by the Examiner on pages 2 and 3 of  
14 the Eighth Office Action) involved situations in which "*res judicata* rejections were reversed"  
15 (underline added).  
16

17 Referring to the cases, cited by the Examiner, in which *res judicata* rejections were  
18 reversed, several of them were based upon the presence of different questions of patentability.  
19 For example, referring to In re Russell, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971), it was  
20 stated

21 Here appellant has made a new record, presenting different questions of patentability even if the  
22 claims are viewed as identical to those in the prior case, as they were in *Herr*. As we pointed out in  
23 In re Craig, 411 F.2d 1333, 56 CCPA 1438 (1969), there is a public interest in granting valid  
24 patents which must be considered against the public interest upon which *res judicata* is based. For  
25 this reason, we reverse the board's decision on the *res judicata* rejection.  
26

27 Thus, similar to the present application, in which Appellant has presented a new record and  
28 presented different questions of patentability (e.g., by identifying the result of a successful test,  
29 which is found on page 2 of the Exhibit A from the First Declaration – thereby supporting



Appellants' contention of actual reduction to practice).

Referring to In re Herr, 377 F.2d 610, 153 USPQ 548 (CCPA 1967), an Examiner rejected claims based upon *res judicata* after Appellant presented new evidence of nonobviousness that overcame the original rejection under 35 U.S.C. § 103. The Court then determined that:

Granted the instant parties and claims are *identical* with those of the parent *Herr* application and, in a *broad* sense, the issue in the original appeal was, as here, whether those claims were allowable in view of the prior art. More to the point, however, the precise issue in the prior *Herr* appeal was whether appellant was entitled to allowance of his claims in the *application* and *record then* on appeal. The precise issue here is whether appellant has legally established his right to those claims in the *application* and *record now* before us. We think he has.

In the present application, similar to In re Herr, a determination has already been made the evidence submitted by Appellants overcomes the presently-applied rejection. Therefore, Appellants have legally established that a rejection of claim 1 based upon Upton in view of Jeffries and Homer cannot legally stand since Upton cannot properly be applied as prior art. Therefore, for the Honorable Board to affirm the Examiner's rejection based upon *res judicata* would, in the words of the In re Herr Court, "unjustly enrich the public at the expense of the inventor."

#### Ninth Office Action

In response to an Appeal Brief filed by Appellants on July 24, 2009 (hereinafter the Third Appeal), the Examiner presented an additional assertion on page 10 of the Ninth Office Action:

Applicants primarily argue that "Examiner's assertion that "this Declaration is also binding with the Broad decision" is incorrect"

Examiner respectfully disagrees. All the prosecutions before Board decision are considered by Board even though there is no issue about the affidavit.

Appellants respectfully disagree.

1  
2 First, the Examiner cites to no case law to support the Examiner assertion that "[a]ll  
3 prosecutions before Board decision are considered by Board." If, for example, an Appellant made  
4 in argument during prosecution but not in an Appeal Brief, these arguments would not be  
5 considered by the Honorable Board. See, e.g., Ex parte Bo Li, 88 USPQ 2d 1695 (BPAI 2008)  
6 (non-precedential) ("Arguments which Appellant could have made but chose not to make in the  
7 Briefs have not been considered and are deemed to be waived."); 37 C.F.R. § 41.37(c)(1)(vii)  
8 ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41  
9 will be refused consideration by the Board, unless good cause is shown"). Thus, contrary to the  
10 Examiner's assertion, not "[a]ll prosecutions before Board decision are considered by Board."

11  
12 Therefore, for the reasons submitted above, Appellant respectfully submits that the  
13 Examiner's reliance upon *res judicata* is inappropriate. Moreover, since the First and Second  
14 Declarations have overcome the Upton reference, the Examiner's rejection of claims 1-2 and 4  
15 based upon Upton in view of Jeffries and Homer cannot stand.

16  
17 **THE REJECTION OF CLAIMS 3-4 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON**  
18 **UPTON IN VIEW OF JEFFRIES, HOMER, AND HARTMANN**

19 For convenience of the Honorable Board in addressing the rejections, claims 3-4 9 stand  
20 or fall together with independent claim 1.

21  
22 Claims 3-4 depend from independent claim 1, and Appellants incorporate herein the  
23 arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §

1 103 for obviousness based upon Upton in view of Jeffries and Homer. Specifically, Upton cannot  
2 be properly applied as prior art. The additional reference to Hartmann does not cure the deficiencies  
3 of the combination of Upton, Jeffries, and Homer. Accordingly, the proposed combination of  
4 references would not yield the claimed invention. Appellants, therefore, respectfully submit that  
5 the imposed rejection of claims 3-4 under 35 U.S.C. § 103 for obviousness based upon Upton in  
6 view of Jeffries, Homer, and Hartmann is not viable.

7  
8 Conclusion

9 Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections  
10 under 35 U.S.C. § 103 for obviousness based upon the applied prior art is not viable. Appellants,  
11 therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35  
12 U.S.C. § 103.

Application No.: 10/041,141

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: February 13, 2010

Respectfully submitted,

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CUSTOMER NUMBER 46320

## **VIII. CLAIMS APPENDIX**

1. An inline error notification method comprising:

detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form;

inserting a row in said markup specified form in a position which is proximate to said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row;

selecting error text corresponding to said validation error and inserting said selected error text in said row;

further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element; and,

serving said markup specified form in a response to said form-based submit, said response referencing said anchor tag.

2. The inline error notification method of claim 1, further comprising the step of:

inserting an error image adjacent to said input-element.

3. The inline error notification method of claim 1, further comprising the steps of:

determining whether said markup specified form contained multiple views, one of said multiple views containing said input-element; and,

if it is determined that said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status.

4. The inline error notification method of claim 1, wherein said step of inserting a row in said markup specified form in a position which is proximate to said input-element comprises the step of:

inserting a row in said markup specified form in a position which is proximate to but below said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row.

5. The inline error notification method of claim 4, wherein said step of further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element comprises the step of:

further inserting an anchor tag in said markup specified form in a position which is proximate to but before said input-element.

**IX. EVIDENCE APPENDIX**

Attached hereto are two Declarations under 37 C.F.R. § 1.131, which have been entered by the Examiner and relied upon by Appellants in this Appeal. The first Declaration was filed December 21, 2004, and the second Declaration was filed December 5, 2005.

**X. RELATED PROCEEDINGS APPENDIX**

On August 29, 2007, a Decision on Appeal was rendered in the present Application, a copy of which is attached hereto. Appellants are unaware of any other related appeals and interferences.